

Confirmation no. 8224

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	VINK	Examiner:	Cardwell, E.
Serial No.:	10/561,461	Group Art Unit:	2189
Filed:	December 20, 2005	Docket No.:	NL030719US1 (NXPS.472PA)
Title:	STORAGE DEVICE FOR STORING DIFFERENT DATA FORMATS		

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No. 65913

Dear Sir:

This is a Reply Brief submitted pursuant to 37 C.F.R. § 41.41(a)(1) for the above-referenced patent application. This Reply Brief is submitted in response to the Examiner's Answer dated December 4, 2009.

Authorization is given to charge/credit **Deposit Account 50-4019 (NL030719US1)** all required fees/overages to enter this paper.

I. Status of Claims

Claims 1-9 stand rejected and are presented for appeal.

II. Grounds of Rejection

The grounds of rejection to be reviewed on appeal are as follows:

Claims 1-9 stand rejected under 35 U.S.C. §103(a) over the Widergren reference (U.S. Patent Pub. 2004/0228169) in view of the Chouinard reference (U.S. Patent No. 6,671,701).

III. Appellant's Reply Argument

Appellant's Reply Brief does not replace the Appeal Brief and the arguments presented therein. The Reply Brief is intended to supplement the Appeal Brief, and the arguments of the Appeal Brief still apply.

The § 103(a) Rejection Of Claims 1-9 Is Improper Because The Rejection Relies On Unsupported "Obvious To Try" And "Design Choice" Arguments.

The § 103 (a) rejection of claims 1-9 is improper because the Examiner has premised the rejection on unsupported "design choice" and "obvious to try" arguments. Either the improper "obvious to try" argument or the impermissible "design choice" argument alone is enough to render the § 103 (a) rejection of claims 1-9 improper.

The Examiner's "Obvious to Try" Argument Is Unsupported

The Examiner has improperly rejected claims 1-9 based on an improper "obvious to try" argument. Under the M.P.E.P. and relevant case law, an asserted combination of references is not "obvious to try" where one would have to vary numerous parameters and the prior art gives no direction as to which of many possible choices is likely to be successful. *See In re Kubin* 561 F.3d 1351 (Fed. Cir. 2009). The Examiner outlines his understanding of the prior art as including devices of two basic designs. The Examiner acknowledges that the claimed invention does not align with either but rather asserts "applicant's invention falls in the middle of the two designs." Examiner's Answer page 4. The Examiner's two cited references, which allegedly represent the two designs, contain no

suggestion as to how one of skill in the art would successfully combine the designs and arrive at Appellant's claimed invention. Rather, the Examiner conjectures a new design which is in no way disclosed in or based on either of the cited references, and argues the new design would be motivated by one desiring to give up encryption based security. As the record stands, the Examiner has not presented any hypothetical embodiment for which to apply the § 103 motivation test.

In characterizing the cited references as falling into two basic designs, the Examiner attempts to over simplify the teachings of the asserted references. In doing so the Examiner overlooks the technical details of each reference and the significant hurdles that would arise in an attempt to reach a workable combination. The '169 reference's device includes multiple transcoders and the '701 reference includes files associated with a source file in a plurality of formats. None of the cited references (or the Examiner's arguments) explains or suggests how to coordinate between numerous transcoders, several different versions of data, and incoming requests for data in a given format. Further, the Examiner relies on the primary purpose of the '169 reference, which is to store all files in an encrypted format to optimize security, to support some of his arguments regarding correspondence. The Examiner then impermissibly removes security for at least some of the data in creating the hypothetical device asserted. With the lack of any such rationale in support of the rejection, it is especially clear that the skilled artisan would not be lead or in any way motivated to implement the Examiner's proposed new (undocumented) design.

As defined by the Examiner, any device is simply "obvious to try" or a "design choice" and § 103(a) may be applied arbitrarily without regards to the standards set forth in U.S. patent law. The "obvious to try" standard may not be applied where one would have "to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful." *In re Kubin* (Fed. Cir. April 3, 2009), interpreting *KSR Int'l Co v. Teleflex Inc.*, 550 U.S. 398 (2007). The asserted combination would, at best, lead to open-ended speculation on how a hypothetical embodiment would operate, which the *Kubin* court has expressly indicated as

improper. The lack of correspondence, discussed in the Appeal Brief, is further evidence of the open-ended speculation inherent in the proposed combination.

The Examiner's "Design Choice" Argument is Unsupported

The design choice argument by the Examiner is equally impermissible as the Examiner's position is contrary to the M.P.E.P. and relevant case law. "The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) cited in M.P.E.P. § 2144.04. The Examiner asserts as a bare conclusion and with no analysis whatsoever of the cited reference, the "design choice [is] a tradeoff [between] reduced security for the decoded file but enhanced operation speed in providing the file to the user." Examiner's Answer page 6. Moreover, the evidence of record plainly contradicts the Examiner's conclusion; as the '169 reference discloses that it can process information faster with higher throughput than other embodiments. *See e.g.*, paragraph 0025. The only evidence of record consistent with enhanced operation speed is Appellant's specification which is different from the proposed modification. The Examiner has failed to provide any evidence of motivation (or teaching) to combine the '169 reference and the '701 reference in a manner that corresponds to the claimed invention. Instead, the Examiner appears to be relying on the Appellant's teachings to direct the changes necessary to create the hypothetical device asserted.

The impropriety of the Examiner's position is illustrated by Appellant's previous teaching away arguments in the Appeal Brief. In responding to the Appeal Brief the Examiner fails to address evidence that the '169 reference teaches away from the asserted combination of references because the modification proposed undermines both the operation and purpose of the '169 reference. The '169 reference is designed to be compatible with multiple different types of electronic systems that process data in different formats. The combination asserted by the Examiner requires the conversion of data into a predefined format prior to delivery or request for data. In attempting to impermissibly remove security from the '169 reference, the Examiner frustrates the system's ability to process different formats, and makes the system effectively inoperable. Appellant therefore requests the § 103(a) rejection of claims 1-9 be reversed.

IV. Conclusion

In view of the above, and the underlying Appeal Brief, Appellant submits that the rejections of claims 1-9 are improper and therefore requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Robert J. Crawford
Reg. No.: 32,122
651-686-6633
(NXPS.472PA)